

**REMARKS**

In the non-final Office Action mailed December 22, 2006, the Examiner objected to claim 1 due to an informality; rejected claim 3 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 1, 2, and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Pub. No. 2004/0211834 by *Fleckenstein et al.* ("*Fleckenstein*"); rejected claims 6, 7, and 13 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Pub. No. 2002/0029202 by *Lopez* ("*Lopez*"); rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over *Fleckenstein* in view of *Lopez*; rejected claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over *Lopez*; rejected claims 5 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Lopez*, in view of U.S. Patent No. 6,539,360 to *Kadaba* ("*Kadaba*"); rejected claims 14, 28, and 30 under 35 U.S.C. § 103(a) as being unpatentable over *Fleckenstein*; rejected claims 15-20 and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Fleckenstein* in view of *Lopez*; rejected claims 21-25 under 35 U.S.C. § 103(a) as being unpatentable over *Fleckenstein* in view of *Kadaba*; and rejected claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Fleckenstein* in view of U.S. Patent Pub. No. US 2003/0233190 to *Jones* ("*Jones*").

By this amendment, Applicants amend claims 1, 3, 5, 6, 12, 13, and 15. Claims 1-30 are pending and under current examination.

Claim 1 is amended to end with a period, thereby overcoming the Examiner's objection to the claim.

**Rejection under 35 U.S.C. § 112 Second Paragraph**

Applicants traverse the rejection of claim 3 under 35 U.S.C. § 112, second paragraph. However, to expedite prosecution, Applicants have amended claim 3 for further clarity. The rejection of claim 3 under 35 U.S.C. § 112 is therefore overcome by the amendment and should be withdrawn.

**Rejections under 35 U.S.C. § 102(e)**

**Claims 1, 2, and 11**

Applicants traverse the rejection of claims 1, 2, and 11 under 35 U.S.C. § 102(e) because the cited portion of *Fleckenstein* does not constitute § 102 prior art of the present application. "If a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. § 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application, such a claim is entitled only to the filing date of the continuation-in-part application." *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995). M.P.E.P. § 201.11(B) (8th ed., 2001, rev. 5, Aug. 2006). Here, *Fleckenstein* was filed on May 18, 2004, and is a continuation-in-part of U.S. Patent No. 6,634,551 (the '551 patent). The '551 patent was filed on March 23, 2001. As such, new matter disclosed in *Fleckenstein* is only entitled to claim the filing date of *Fleckenstein*, May 18, 2004, as its priority date. Accordingly, the new matter disclosed in *Fleckenstein* is not § 102 prior art to the present application which was filed on October 15, 2001.

The portion of *Fleckenstein* cited by the Examiner in rejecting claim 1 is new matter in *Fleckenstein*. For example, the Examiner asserted that "notifying, based on

the first delivery point, a recipient that the item is en route,” as recited in claim 1, is disclosed in paragraph [0101] of *Fleckenstein*. (OA at 3.) However, the cited paragraph in *Fleckenstein* is not disclosed in the '551 patent. Paragraph [0101] in *Fleckenstein* discloses “[a] personal profile” in relation to Fig. 5A. This element of the specification was not present in the '551 patent. As such, the cited paragraph describing “the personal profile” is new matter, and is entitled only to a priority date of May 18, 2004. Accordingly, paragraph [0101], which has a priority date later than the filing date of the present application, cannot be used as prior art in rejecting any claim of the present application.

At least for the reason that the cited portion of *Fleckenstein* does not constitute § 102 prior art as to the present application, *Fleckenstein* does not anticipate claim 1. Although of different scope, independent claim 11 recites features similar to those of claim 1. Therefore, *Fleckenstein* also does not anticipate claim 11, for at least the reasons set forth with respect to claim 1. Claim 2 depends from claim 1. For at least the reasons set forth with respect to independent claim 1, *Fleckenstein* also does not anticipate dependent claim 2. As such, the rejection of claims 1, 2, and 11 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Claims 6, 7, and 13

Applicants traverse the rejection of claims 6, 7, and 13 under 35 U.S.C. § 102(e) because *Lopez* does not teach each and every element of the claims. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8th ed., 2001, rev. 5, Aug. 2006).

Independent claim 6, as amended, recites “changing a delivery point of an item while the item is en route.” *Lopez* fails to teach at least this claim element. *Lopez* discloses a system for routing mailpieces undeliverable as originally addressed. (Abstract.) *Lopez* discloses that the system may “generate a single scan image of address block attributes that is segmented into discrete indicators for subsequent generation of forwarding addresses and sender notifications so mailpieces are processed in a single operation.” (*Id.*) “The segmented image also provides the information needed to generate sender notifications when such are requested.” (*Id.*) “Mailpieces to be returned to senders are similarly processed in a single operation.” (*Id.*) *Lopez*, however, does not teach or suggest “changing a delivery point of an item while the item is en route,” as recited claim 6.

At least for the reason that *Lopez* does not disclose each and every element recited in claim 6, *Lopez* does not anticipate claim 6. Although of different scope, claim 13 recites features similar to those of claim 6. Therefore, *Lopez* also does not anticipate claim 13 for at least the reasons set forth with respect to claim 6. Claim 7 depends from claim 6. For at least the reasons set forth with respect to independent claim 6, *Lopez* also does not anticipate dependent claim 7. As such, the rejection of claims 6, 7, and 13 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

**Rejections under 35 U.S.C. § 103(a)**

**Claims 3 and 4**

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with regard to claim 1, because *Fleckenstein* and *Lopez*, taken alone or in combination, do not teach or suggest each and every element of claim

1. To establish a prima facie case of obviousness, the prior art (taken separately or in combination) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

As discussed above, *Fleckenstein* does not teach or suggest “notifying, based on the first delivery point, a recipient that the item is en route,” as recited in claim 1. *Lopez* does not cure the deficiencies of *Fleckenstein*. *Lopez* discloses a system for routing mailpieces undeliverable as originally addressed. (Abstract.) *Lopez*, however, does not teach “notifying, based on the first delivery point, a recipient that the item is en route,” as recited in claim 1. Accordingly, the prior art, taken separately or in combination, fails to disclose each and every element of claim 1.

Claim 3 and 4 depend from claim 1. At least for the same reasons given above related to claim 1, the prior art, taken separately or in combination, also fails to disclose each and every element of dependent claims 3 and 4. Accordingly, the rejection of claims 3 and 4 under 35 U.S.C. § 103(a) should be withdrawn and the claims should be allowed.

#### Claims 8-10

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with regard to claim 6, because the prior art, *Lopez*, does not teach or suggest each and every element of claim 6. As explained above, *Lopez* does

not teach or suggest “changing a delivery point of an item while the item is en route,” as recited claim 6.

Claims 8-10 depend from claim 6. At least for the same reasons given above in relation to claim 6, the prior art, *Lopez*, also fails to disclose each and every element of dependent claims 8-10. Accordingly, the rejection of claims 8-10 under 35 U.S.C. § 103(a) should be withdrawn and the claims should be allowed.

Claims 5 and 12

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with regard to claim 5, because *Lopez* and *Kadaba*, taken alone or in combination, do not teach or suggest each and every element of claim 5.

Independent claim 5 recites “allowing the sender to specify that the item is to be delivered to a second delivery point.” *Lopez* discloses a system for routing mailpieces undeliverable as originally addressed. (Abstract.) However, *Lopez* does not teach or suggest the above claim element.

*Kadaba* does not cure the deficiencies of *Lopez*. *Kadaba* discloses a method and system for processing packages designated for special handling and notifying an appropriate party as to whether special handling has been applied to these designated packages. (Abstract.) *Kadaba*, however, also does not teach or suggest “allowing the sender to specify that the item is to be delivered to a second delivery point,” as recited in claim 5. Accordingly, *Lopez* and *Kadaba*, taken separately or in combination, fail to disclose each and every element of claim 5.

Although of different scope, claim 12 recites features similar to those of claim 5. At least for the same reasons given above related to claim 5, the prior art, taken

separately or in combination, also fails to disclose each and every element of independent claims 12. Accordingly, the rejection of claims 5 and 12 under 35 U.S.C. § 103(a) should be withdrawn and the claims should be allowed.

Claims 14, 28, and 30

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with regard to claims 14, 28, and 30, because *Fleckenstein* does not teach or suggest each and every element of the claims. Claim 14 recites “providing a notification to indicate that the item is en route to the first delivery point.” As explained above in relation to claim 1, *Fleckenstein* does not teach these claim elements. As such, *Fleckenstein* fails to disclose each and every element of claim 14.

Although of different scope, claim 30 recites features similar to those of claim 14. At least for the same reasons given above related to claim 14, no prima facie case of obviousness has been established for independent claim 30. Claim 28 depends from claim 14. At least for the reason that *Fleckenstein* fails to disclose each and every element of independent claim 14, no prima facie case of obviousness has been established for dependent claim 28. Accordingly, the rejection of claims 14, 28, and 30 under 35 U.S.C. § 103(a) should be withdrawn and the claims should be allowed.

Claims 15-20 and 29

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with regard to claims 15-20 and 29 because *Fleckenstein* and *Lopez*, taken alone or in combination, does not teach or suggest each and every element of the claims. Claim 14 recites “providing a notification to indicate that the item

is en route to the first delivery point.” As explained above in relation to claim 1, *Fleckenstein* does not teach these claim elements.

*Lopez* does not cure the deficiencies of *Fleckenstein*. *Lopez* discloses a system for routing mailpieces undeliverable as originally addressed. (Abstract.) *Lopez*, however, also does not teach or suggest “providing a notification to indicate that the item is en route to the first delivery point,” as recited in claim 14. As such, *Fleckenstein* and *Lopez*, taken alone or in combination, fail to teach each and every element of claim 14.

Claims 15-20 and 29 depend from claim 14. At least for the reason that *Fleckenstein* and *Lopez* fail to disclose each and every element of independent claim 14, no prima facie case of obviousness has been established for dependent claims 15-20 and 29. Accordingly, the rejection of claims 15-20 and 29 under 35 U.S.C. § 103(a) should be withdrawn and the claims should be allowed.

#### Claims 21-25

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with regard to claims 21-25, because *Fleckenstein* and *Kadaba*, taken alone or in combination, do not teach each and every element of the claims. Claim 14 recites “providing a notification to indicate that the item is en route to the first delivery point.” As explained above in relation to claims 1 and 14, *Fleckenstein* does not teach at least these claim elements.

*Kadaba* does not cure the deficiencies of *Fleckenstein*. *Kadaba* discloses a method and system for processing packages designated for special handling and notifying an appropriate party as to whether special handling has been applied to these



designated packages. (Abstract.) *Kabada*, however, also does not teach or suggest “providing a notification to indicate that the item is en route to the first delivery point,” as recited in claim 14. As such, *Fleckenstein* and *Kadaba*, taken alone or in combination, fail to teach each and every element of claim 14.

Claims 21-25 depend from claim 14. At least for the reason that *Fleckenstein* and *Kadaba*, taken alone or in combination, fail to disclose each and every element of independent claim 14, no prima facie case of obviousness has been established for dependent claims 21-25. Accordingly, the rejection of claims 21-25 under 35 U.S.C. § 103(a) should be withdrawn and the claims should be allowed.

Claims 26 and 27

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with regard to claims 26 and 27 because *Fleckenstein* and *Jones*, taken alone and in combination, do not teach each and every element of the claims. Claim 14 recites “providing a notification to indicate that the item is en route to the first delivery point.” As explained above in relation to claim 1, *Fleckenstein* does not teach these claim elements.

*Jones* does not cure the deficiencies of *Fleckenstein*. *Jones* discloses a system “for permitting a user to define a plurality of different predetermined proximities corresponding respectively with a plurality of different mobile vehicles in relation to a location, for monitoring travel data associated with the plurality of mobile vehicles, and for notifying one or more communications devices associated with the user based upon the different predetermined proximities associated with the vehicles.” (Abstract.) *Jones*, however, also does not teach or suggest “providing a notification to indicate that

the item is en route to the first delivery point," as recited in claim 14. As such, *Fleckenstein* and *Jones*, taken alone or in combination, fail to teach each and every element of claim 14.

Claims 26 and 27 depend from claim 14. At least for the reason that *Fleckenstein* and *Jones*, taken alone or in combination, fail to disclose each and every element of independent claim 14, no prima facie case of obviousness has been established for dependent claims 26 and 27. Accordingly, the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) should be withdrawn and the claims should be allowed.

### **Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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